

## REMARKS

### 1. Formal Matters

#### a. Status of the Claims

Claims 5 and 6 are pending and under active consideration in this application. Claim 5 is amendment and claims 13 and 14 are new. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the application. Upon entry of these amendments, claims 5, 6, 13, and 14 will be pending and under active consideration.

#### b. Amendment of the Claims

The amendment to claim 5 does not change the scope but only clarifies the patient population in need of treatment due to damaged tissue attributable to heart disease. New claims 13 and 14 are directed to a method of treating damage to normal tissue attributable to heart disease by administering to a patient in need thereof the Applicant's elected compound SF1740 wherein R is  $\text{NHCOCH}_2\text{Oph}$ . Support for new claims 13 and 14 can be found throughout the specification, for example, paragraphs 0072, 0112, 0113, and Example 40. The Examiner has acknowledged on page 2 of the Office Action the lack of prior art teaching Applicants elected compound.

### 2. Patentability Remarks

#### a. 35 U.S.C. §102(b)

On pages 3-7 of the Office Action, the Examiner rejects claim 5 under 35 U.S.C. §102(b) over U.S. Patent Appl. Pub. No. 2003/0207812 (hereafter "Chapdelaine") as evidenced by Ross et al., *New Engl. J. Med.* 340:115-126 (1999) (hereafter "Ross"). Applicant respectfully disagrees.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). Amended claim 5 recites, in part, a method of treating damage to normal tissue attributable to heart disease by administering to a patient in need thereof a certain compound. The Examiner characterizes Chapdelaine using a certain compound to treat T-cell mediated diseases. Chapdelaine does not teach or suggest using the compound for treating heart disease. The anticipation rejection is based on the Examiner's assertion that heart disease is a species of T-cell related diseases as evidenced by Ross. The disclosure of the genus of T cell related diseases discussed in Chapdelaine does not anticipate the species of heart disease.

One of skill would be unable to at once envisage that the compound taught in Chapdelaine would treat atherosclerosis because Chapdelaine fails to specifically delineate T-cell mediated conditions. Chapdelaine simply teaches the treatment of immunologically related diseases, autoimmune disorders, and organ graft rejection (see abstract, paragraphs 0002-0007, and claim 7 of Chapdelaine). Chapdelaine

fails to further describe atherosclerosis or for that matter, any other specific T-cell mediated conditions. Performing a very rudimentary search of autoimmune diseases in Wikipedia results in over 46 autoimmune related T cell mediated diseases each with specific mechanism of action (see Appendix A). A similar search of immune system disorders in Wikipedia results in over 100 disorders many of which are related to T-cell mediation and again subject to specific mechanisms of action (see Appendix B). The Examiner will further note that atherosclerosis is not listed in either search result. Because of the expansiveness of T-cell related diseases and the complexity of their mechanisms of action, Chapdelaine would need to provide some sort of guidance to one of skill to readily envisage that treatment with Chapdelaine's specific compound would necessarily treat atherosclerosis. This is not the case. The disclosure of Ross does nothing to guide one of skill that Chapdelaine's compound would be able to treat this specific T-cell mediated disease. Therefore, the class of T-cell related diseases fails to be sufficiently limited or well delineated by Chapdelaine. Accordingly, Applicant submits that amended claim 5 fails to be anticipated by the teachings of Chapdelaine. In view of the foregoing amendment and remarks, Applicant respectfully submits that the rejection of claim 5 under 35 U.S.C. §102(b) over Chapdelaine is improper and should be withdrawn.

**b. 35 U.S.C. §103(a)**

On pages 7-10 of the Office Action, the Examiner rejects claim 6 under 35 U.S.C. §103(a) over Chapdelaine as evidenced by Ross. Applicant respectfully disagrees.

As discussed above, Chapdelaine fails to teach or suggest using its' compound to treat heart disease. This fundamental defect of Chapdelaine is not remedied by the Examiner's position that since patients with heart disease usually suffer from other coexisting diseases (e.g., hypertension), one would be motivated and it would be routine in the medical art to treat the patient with the instantly claimed compounds prior to, together with, or after a treatment for the other coexisting disease. Accordingly, Chapdelaine does not teach or suggest all the limitations of claim 6. In view of the foregoing remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 6 under 35 U.S.C. §103(a) over Chapdelaine.

### 3. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance or better condition for appeal. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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Dated: January 30, 2009

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